

II. Double Patenting Rejection

The Examiner maintained the rejection of claims 38-58, 60, 69, 78, 79, 83, 84, and 88-106 under the judicially created doctrine of obviousness-type double patenting over claims 1-41 of U.S. Patent No. 6,346,234 to Rollat et al. ("*Rollat*"), in view of EP 0 551 749 to Lee et al. ("*Lee*"). Final Office Action, page 2. Specifically, the Examiner alleged that the "tacky polymer" claimed in the present invention "are exactly the same as those 'anionic fixative polymer' defined in claim 12 of [*Rollat*], for which a particular example is commercial product polymer AQ 1350 (see col. 3, lines 29-58 for particular definition and examples for the formula in claim 13)." *Id.* at page 5. The Examiner admitted that the claims of *Rollat* "do not expressly recite the second polymer [claimed in the present invention, i.e.,] the fixing polymer." *Id.* at page 6. However, the Examiner alleged that *Lee*, "as secondary reference, is cited to show the level of the art, and therefore is not limited to the claims therein." *Id.* Applicants respectfully traverse this rejection for at least the following reasons.

First, contrary to the Examiner's allegation, the tacky polymer claimed in the present invention has "a glass transition temperature (Tg) of less than 20 °C," and therefore, is not exactly the same as the "anionic fixative polymer" defined in claim 12 of *Rollat*. Even though the scope of the tacky polymer claimed in the present invention may overlap with the polymer claimed in *Rollat*, e.g., AQ 1350 disclosed in the present application is also disclosed as an example of the claimed polymer in *Rollat*, it does not mean that the tacky polymer claimed in the present invention having a glass transition temperature (Tg) of less than 20 °C is "exactly the same" as the claimed polymer in *Rollat* as alleged by the Examiner. Indeed, examples of other polymers with Tg of less

than 20 °C disclosed in *Rollat*, such as Neocryl BT 67 in Example 1, KRATON G1701 in Example 2, ECOCRYL XP 4501 in Example 3, and CARBOTAC XPD 1811 in Example 4, are not part of *Rollat*'s claimed invention because their physical properties do not fall into the range as claimed therein.

Therefore, to arrive at the presently claimed invention, one has to pick and choose polymers from the claimed polymer in *Rollat*, and combine such a polymer with the fixing polymer claimed in *Lee*. However, the Examiner has failed to point to any evidence of a suggestion or motivation to pick and choose, let alone evidence of a motivation to combine.

Further, Applicants respectfully submit that the Examiner's allegation that *Lee* "is not limited to the claims therein" is improper. The M.P.E.P. clearly instructs that one significant difference between an obviousness-type double patenting rejection and an obviousness rejection is that "a double patenting rejection must rely on a comparison with the claims in [the prior art] while an obviousness rejection based on the same [prior art] relies on a comparison of what is disclosed (whether or not claimed) in the same [prior art]." M.P.E.P. §804(III) (emphasis added).

Accordingly, Applicants respectfully request this rejection be withdrawn.

III. Rejection Under 35 U.S.C. § 112, First Paragraph

The Examiner maintained the rejection of claims 38-43, 45-50, 69, 78, 79, 83, 84, and 88-106 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Final Office Action, page 3. Specifically, the Examiner alleged that the term "tacky polymer" used in the claims of the present invention is a functional

limitation, and pages 4-6 of the present specification cited in Applicants' Request for Reconsideration dated October 21, 2004, "merely provide guidance as to how to determine the functional limitation set forth herein, [but] fail to give any information as to the structure-property relationship, thereby fail to provide a written description for the 'tacky polymer' encompassed herein." *Id.* at page 6. Applicants respectfully traverse this rejection for at least the following reasons.

First, the M.P.E.P. clearly instructs that "[t]he written description requirement for a claimed genus may be satisfied through sufficient description of a representative number of species by actual reduction to practice . . . or by disclosure of relevant, identifying characteristics, i.e., structure or other physical and/or chemical properties[.]" M.P.E.P. §2163 II.A.3(a).ii) (citing *Regents of the University of California v. Eli Lilly*, 119 F.3d 1559, 1568, 43 USPQ2d 1398, 1406 (Fed. Cir. 1997)) (emphasis added).

Therefore, contrary to the Examiner's allegation, it is not necessary to disclose the structure of all chemical compounds in a genus claim in order to satisfy the written description requirement. Disclosure of relevant, identifying characteristics, such as physical and/or chemical properties can also satisfy the written description requirement.

Here, pages 4-6 of the present description provides guidance on how to determine the maximum peeling force F_{\max} and the energy for separation $E_{s(M/V)}$, which are physical properties of the "tacky polymer" as presently claimed. They are not functional limitations as alleged by the Examiner.

Further, the present specification provides embodiments of the "tacky polymer" as presently claimed, such as branched sulphonic polymers or (meth)acrylic ester polymers on page 6, lines 21-23, guidance on how to form the branched sulphonic

polyester and the (meth)acrylic ester and specific examples thereof on page 7, lines 5 - page 12, line 16. Therefore, the present specification provides sufficient written description.

Finally, the M.P.E.P. clearly instructs that there is a strong presumption that an adequate written description of the claimed invention is present when the application is filed. M.P.E.P. § 2163(I)(A) (citing *In re Wertheim*, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976)). The Examiner has not met the burden to overcome this presumption in the present rejection, especially in view of the U.S. Patent & Trademark Office's examination guidelines on Written Description, page 4, at www.uspto.gov/web/menu/written.pdf. See Request for Reconsideration filed October 21, 2004, pages 4-6. Therefore, this rejection is improper.

Accordingly, Applicants respectfully request this rejection be withdrawn.

IV. Rejection Under 35 U.S.C. § 103 (a)

The Examiner also maintained the rejection of claims 38-58, 60, 69, 78, 79, 83, 84, and 88-106 under 35 U.S.C. §103 over *Lee* in view of WO 95/18191 to Miller et al. ("*Miller*"). Final Office Action, page 4. Specifically, in response to Applicants' argument that the Examiner has failed to provide sufficient motivation to combine *Lee* and *Miller*, the Examiner alleges that "the teaching, suggestion, and motivation are found in both [] references and in the knowledge generally available to one of ordinary skill in the art." *Id.* at page 7. According to the Examiner, because *Lee* teaches a "hair composition with a combination of polyesters functionalized with a sulpho group such as Eastman AQ polymers (see page 3, lines 15-20) and acrylate-based copolymers such as

octylacrylamide/acrylates/butylaminoethyl methacrylate copolymer” and *Miller* “teaches improved branched sulfonic polyester with low Tg,” which provides the “advantage that the composition will not be brittle at low temperature, thus maintains its property,” it would have been obvious to use the improved branched sulfonic polyester with low Tg disclosed in *Miller* in *Lee*’s composition. *Id.* at pages 7-8. Applicants respectfully traverse this rejection for at least the following reasons.

First, *Miller* clearly teaches that “[t]he preferred Tg of the adhesive composition according to the present invention is below 10 °C.” Page 18, lines 1-3. *Miller* further teaches that a “low Tg means that the adhesive compositions will not be brittle[.]” *Id.* at lines 10-11. Therefore, contrary to the Examiner’s allegation, the low Tg taught in *Miller* does not refer to the “improved branched sulfonic polyester” but “the adhesive composition” disclosed therein.

Second, in making a § 103(a) rejection, the Examiner must consider the prior-art reference in its entirety, *i.e.*, as a whole, including portions that would lead away from the claimed invention. M.P.E.P. § 2141.02 (citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983)) (emphasis in original).

Indeed, *Lee* teaches away from using Eastman AQ polymers with a Tg lower than 20 °C in combination with its water-soluble amphoteric polymer, such as acrylate copolymers, because *Lee* teaches that among “Eastman AQ polymers,” those having “a glass transition temperature ranging from about 50 °C to about 70 °C, preferably around 55 °C” are preferred. Page 3, lines 17-19; see Appeal Brief filed January 7, 2004, pages 9-10. Therefore, this rejection is improper.

Accordingly, Applicants respectfully request this rejection be withdrawn.

V. Conclusion

In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

If the Examiner believes a telephone conference would be useful in resolving any outstanding issues, he is invited to call the undersigned Applicants' representative at (202) 408-4218.

If there is any fee due in connection with the filing of this response, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

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